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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,250	10/31/2003	Abigail Jane Sellen	200308878-2	9921

22879 7590 01/04/2007
HEWLETT PACKARD COMPANY
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INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

CAPUTO, LISA M

ART UNIT	PAPER NUMBER
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2876

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/697,250	SELLEN ET AL.	
	Examiner	Art Unit	
	Lisa M. Caputo	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1003</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the United Kingdom on 15 January 2003. It is noted, however, that applicant has not filed a certified copy of the application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Ostrover et al. (U.S. Patent No. 6,585,154, from hereinafter "Ostrover").

Ostrover teaches a system, method, and device for documents with electronic copies attached thereto. Regarding claims 1-2, 8, and 23-24, Ostrover teaches a published document (document 42) comprising a printed document (printed, written item containing visually perceptible data) and at least one memory attached to the printed document (microchip 22 which includes a memory device capable of storing data and a means for affixation to a document), wherein the memory comprises an electrical circuit without an integral power source but may be powered wirelessly or inductively (for

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example, it can be embodied as a TIRIS™ radio frequency transponder tag) so that it may transmit information wirelessly, wherein at least a portion of the information stored in the published document for display to the user is provided in the memory (the microchip 22 contains an electronic copy of at least a portion of a content of document 42 printed thereon) (see Figure 2, col 4 lines 5-37, col 4 line 65 to col 5 line 35, col 6, lines 15-45).

Regarding claims 3-4, Ostrover teaches that a portion of the information stored in the memory for display to the user comprises information for combination with user provided information (via coded information from a computer 44 or PDA 38 input etc.) to provide further information to display to the user (see Figures 1-2, col 6, lines 25-40).

Regarding claims 5-7, Ostrover teaches that a portion of the information stored in the memory comprises information in an image, video (image and sound), or text format when it is taught that the electronic copy contains data of at least one type selected from the group consisting of text, at least one image, at least one color, sound and at least one texture (see col 2, lines 33-37).

Regarding claims 9-15, Ostrover teaches a reader device for reading information (and hence a method of viewing information) from an unpowered memory circuit attached to a printed document wherein the reader comprises a circuit for providing power to the memory circuit so data can be transmitted, a decoder to read information transmitted by a transmitter of the memory circuit and a display circuit for providing information received by the decoding circuit for display. More specifically, method 60 may further include the step of reading 72 the electronic data. Reading 72 may result in

data display 74, for example by printing or display on a computer monitor or transmission of a fax message. Reading 72 the electronic data may be performed, for example, by a machine selected from the group consisting of computer 44, a personal digital assistant 38, telephone 40, a photocopy machine, a fax machine 46 and a dedicated chip reader 26. Also, there is a chip reading device 26 for reading an electronic copy of at least a portion of the content of document 42 attached thereto. Device 26 may be, for example, integrated into a machine including but not limited to computer 44, personal digital assistant 38, telephone 40, a photocopy machine or a fax machine 46, and is removably attachable to the printed document (see Figures 1-2, col 6, lines 33-52). Further, Ostrover teaches that the tag can be a TIRIS™ tag and can be powered inductively. TIRIS™ employs radio transmissions to send energy to a transponder which returns a radio transmissions back to a data collection reader. The TIRIS™ transponder (tag) is attachable to or embeddable in objects, such as documents. A TIRIS™ reader-unit sends a radio frequency wave to the tag, and the tag broadcasts its stored data back to the reader. Data collected from a transponder can either be sent directly to a computer, or it can be stored in a reader and later sent to a computer for data processing via a wireless link connecting objects with information management systems (see col 4, lines 5-23).

Regarding claims 16-22, Ostrover teaches a method of publishing a document comprising determining first information for viewing by a user to be printed in a printed document and second information for viewing by a user to be written to one or more memory circuit attached to the printed document, printing the first information on a print

medium and writing the second information into one or more memory circuits attached to the printed document wherein the one or more memory circuits are adapted to be powered and read wirelessly by a reader device via a printer to print legible copy of data on a writing surface and via data entry 62 and chip loading 64. In addition, Ostrover discloses that the chips can be affixed in different positions on the printed document 42 or a blank writing surface upon which document 42 may be printed with a physical indication of the memory circuit (i.e. positions associated with the printing of the first information in the printed document) and the chips can be affixed (affixation 68) before or after writing the second information) (see Figure 1, col 5, lines 45-50, col 6, lines 15-45).

Examiner's Note

3. Examiner has cited particular column and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the Applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the Prior Art or disclosed by the Examiner.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Patent No. 6,198,875 to Edenson et al. which teaches TIRIS based Bios for protection of copyrighted program material, U.S. Patent No. 5,905,798 to

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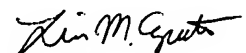
Nerlikar et al. which teaches TIRIS based Kernal for protection of copyrighted program material, and U.S. Patent No. 6,827,279 to Teraura which teaches a sheet of printing paper with an RFID tag for storing and transmitting data through radio wave signals.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Lisa M. Caputo** whose telephone number is **(571) 272-2388**. The examiner can normally be reached between the hours of 8:30AM to 5:00PM Monday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached at **(571) 272-2398**. The fax phone number for this Group is (571) 273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**lisa.caputo@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lisa M. Caputo

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December 23, 2006